

### Remarks

The Applicants respectfully maintain that the application is in condition for allowance. Reconsideration and reexamination is respectfully requested in view of the following remarks.

### DRAWING OBJECTION

In the Office Action at paragraph 5, Figure 2 is objected to for including reference sign "213" not mentioned in the description. Applicants appreciate the Examiner's assistance in identifying this typographical error. In response, the Applicants have amended the specification to correctly reference hard disk drive 213. As such, withdrawal of the objection is respectfully requested.

### SPECIFICATION OBJECTION

In the Office Action at paragraph 6, the specification is objected to because reference sign "212" was used to designate both a hard disk drive and a BIOS. In response, the Applicants have amended the specification to correctly reference BIOS 212 and hard disk drive 213.

Removal of the objection to the specification is therefore respectfully requested.

### 35 U.S.C. § 103 REJECTION

In the Office Action at paragraph 9, claims 1-27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Goodwin et al. (US 6,158,049) in view of Levine, et al. (US 6,349,406) and further in view of Shah et al. (US 6,205,545). This rejection is respectfully traversed, and reconsideration is respectfully requested in view of the following remarks.

Claim 1 recites a computing system including permanently inserted performance markers.

The rejection concedes that neither Goodwin nor Levine discloses or suggests permanently inserted performance markers, as recited by claim 1. See Action, p. 5, ll. 12 and 13.

The rejection cites column 8, lines 53-65 Shah as disclosing a debugging tool including debugging code that stays in the native code pool where it is rarely used, so that the code remains instrumented. This characterization of Shah is respectfully traversed.

Shah discloses a tool wherein debugging flags can be set and unset to enable and disable sections of code associated with debugging. Shah notes that the tool is applicable to "code that has been instrumented." Shah, col. 8, ll. 53-55. There is no suggestion in Shah that any of the

debugging code is permanently inserted, as required by claim 1. For example, Shah fails to disclose or suggest that the instrumented code is permanently inserted.

In addition, as noted above, the tool disclosed by Shah is directed at code used for debugging. Shah fails to disclose or suggest that such a tool could be used for purposes of measuring performance of a program. Therefore, one skilled in the art would not be motivated to combine the software performance profiling system disclosed by Goodwin with the debugging tool disclosed by Shah, since Goodwin's system is directed at solving a different problem (performance measuring) than Shah's tool (debugging).

Further, even if one did combine Goodwin and Shah, the resulting combination would not result in permanently inserted performance markers, as recited by claim 1. This is illustrated by the following statement in the Action: "One would be motivated to [combine Goodwin and Shah] to gain the advantages of retaining debugging features while reducing overhead associated with those features." Action, p. 5. ll. 21 and 22. Therefore, as illustrated by this section of the Office Action, the combination of Goodwin and Shah would result in enhanced debugging, but would not result in permanently inserted performance markers, as recited by claim 1.

For at least these reasons, reconsideration and allowance of claim 1, as well as claims 2-12 that depend therefrom, are respectfully requested.

Claims 13 and 18, although not identical in scope to claim 1, include limitations similar to those noted above with respect to claim 1. For example, claims 13 and 18 recite permanently inserting one or more code markers. Therefore, claims 13 and 18, as well as claims 14-17 and 19-27 that depend therefrom, should be allowable for at least similar reasons to those noted above with respect to claim 1. Reconsideration and allowance are requested.


## CONCLUSION

The remarks set forth above provide certain arguments in support of the patentability of the pending claims. There may be other reasons that the pending claims are patentably distinct over the cited references, and the right to raise any such other reasons or arguments in the future is expressly reserved.

For all of the above reasons, the Applicants respectfully maintain that the pending claims are in condition for allowance. The Applicants respectfully request that the above objections and rejections be withdrawn and the application be passed for allowance.

Respectfully submitted,  
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Date: May 25, 2004

  
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